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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,284	04/11/2000	Hiroshi Satomi	862.C1892	4978
5514	7590	01/21/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			COLBERT, ELLA	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/547,284	SATOMI ET AL.	
	<b>Examiner</b> Ella Colbert	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 01 November 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-5,9-25,29-33,37-45,47,49-55,60,88,91,95 and 104-108 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5, 9-25, 29-33, 37-45, 47, 49-55, 60, 88, 91, 95, & 104-108 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>06 December 2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____ .                                  |

## **DETAILED ACTION**

1. Claims 1, 3-5, 9-25, 29-33, 37-45, 47, 49-55, 60, 88, 91, and 104-108 are pending. Claims 6-8, 26-28, 34-36, 46, 48, 56-59, 61-87, 89, 90, 92-94, and 96-103 have been canceled in this communication filed 09/28/04 entered as Response After Non-Final Action and the Election/Restriction response of 07/15/04. The IDS received 12/06/04 has been considered.

### ***Claim Objections***

2. Claims 2, 4, 5, 9-13, 15, 17, 18, 22, 23, 25, 32, 33, 37-41, 43, 45, 47, 52, 53, and 55 are objected to because of the following informalities: Claim 2 recites "The method according to claim 1, characterized in that the code is inputted by a terminal apparatus connected to a network". This claim limitation would be better recited as "The method according to claim 1, wherein the code is input by a terminal apparatus connected to a network". Claims 4, 5, 9-13, 15, 17, 18, 22, 23, 25, 32, 33, 37-41, 43, 45, 47, 52, 53, and 55 have a similar problem. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites "..., said method comprising: an extraction

step of searching a first database for first information ...". This limitation does not make sense because the database has to be searched prior to extracting information.

Claims 1 and 29 are rejected under 35 U.S.C. 112, second paragraph. Claim 1 recites the limitation in lines 10-12 "an attachment step of attaching a second information that is extracted from ..." and in lines 13 and 14 "an output step of outputting the first information with the second information attached thereto in said attached step in accordance with the layout, wherein:". Claim 29 has a similar problem. There is insufficient antecedent basis for this limitation in the claim.

The claim language of the claims appears to be a literal translation from a foreign application which makes the claim language very unclear for US practice.

Applicants' are advised to review the proper format for claims in patent reference number 6304904 (Sathyanarayan et al).

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-5, 9-25, 91, 104, and 105 are rejected under 35 U.S.C. 101 as non-statutory. The method claims as presented do not claim a technological basis in the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim at least one structural/functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte

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Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) – used only for content and reasoning since not precedential].

Claims 29-33, 37-45, 47, 49-55, 60, 88, 95, 106, and 108 merely suggest technology in the body of the claim and are also rejected under 35 U.S.C. 101 as non-statutory. Claim 29 recites “An information providing system for providing information to a user, said system comprising: an extraction circuit ....”. This claim merely suggests technology. This claim needs a machine in order for the extraction circuit to search the first database ...”. Claim 60 recites “A computer-readable storage medium storing a program for implementing an information method for providing information to a user, the program comprising:”. A storage medium is not considered to be statutory unless the storage medium embodies program instructions to perform the steps that follow, comprising: a computer readable storage medium embodying instructions for the program code to perform a step for searching and extraction from a first database first information corresponding to a user input code.”

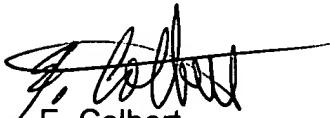
***Inquiries***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The Examiner normally works a Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E. Colbert  
January 18, 2005